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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,196	03/14/2001	Christopher Paul Kenneth Smithies	111828.120US1	1727

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EXAMINER

VIG, NARESH

ART UNIT PAPER NUMBER

3629

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/805,196	SMITHIES ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Naresh Vig	3629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This is in reference to response received 22 December 2005 to the office action mailed 01 December 2005. Claims 1 –29 are pending for examination.

In the response received, applicant argues that all the claims should be examined together because it would not present undue burden on the examiner. However, upon further reading of the claimed invention, at least for the reasons given below, examiner believes that the search may present undue burden on examiner.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 – 10, 21 and 27 drawn to recording evidence of consent by a voice recording system to a transaction involving a relying party and an affirming party, wherein a transaction identifier is provide to the relying party, and this transaction identifier is transmitted by the relying party to the affirming party, classified in class 705, subclass 1.
- II. Claims 11 – 16, 22 – 23 and 28 – 29 drawn to recording consent to a transaction using a voice recording system, wherein a transaction identifier is received by both the relying party and the affirming party at the voice recording system.  
Claims 28 – 29 which are directed to computer readable medium positively claim

that the transaction identifier from the affirming party is received by the voice recording system, whereas the method claims does not positively claim where the transaction identifier is received from. To expedite the prosecution of this application, examiner reads method claims to receive transaction identifier from the affirming party, classified in class 705, subclass 1.

- III. Claims 17 and 18, drawn to obtaining evidence of consent to a transaction involving a relying party and an affirming party wherein the relying party associates a transaction identifier with the transaction, and, provides this transaction identifier to the affirming party, classified in class 705, subclass 1.
- IV. Claims 19 and 20, drawn to method for gathering evidence of assent to a proposition, wherein, an identifier is assigned to a proposition associating a party to the proposition, and this identifier is communicated to the party to enable the party to record a spoken declaration of assent to the proposition, classified in class 705, subclass 1.
- V. Claims 24 – 26, drawn to entering into a contract wherein a party receives a contract and instructions, communications between the party to the contract and the recording system is established; recording system provides recording identifier to the party, classified in class 705, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

In invention I relying party relying party providing the received transaction identifier to the affirming party. There are no contracts and instructions provided to a party, there is no providing of the recording identifier to the relying party, no step wherein relying party associates a transaction identifier with the transaction, and, provides this transaction identifier to the affirming party, and, does not associate a party to the proposition by assigning an identifier to the proposition.

In invention II a transaction identifier is received by both the relying party and the affirming party at the voice recording system. There are no contracts and instructions provided to a party, affirming party does not receive transaction identifier from the relying party, no step wherein relying party associates a transaction identifier with the transaction, and, provides this transaction identifier to the affirming party, and, does not associate a party to the proposition by assigning an identifier to the proposition.

In invention III the relying party associates a transaction identifier with the transaction, and, provides this transaction identifier to the affirming party. There are no contracts and instructions provided to a party, affirming party does not receive transaction identifier from the relying party, and, does not associate a party to the proposition by assigning an identifier to the proposition.

In invention IV an identifier is assigned to a proposition associating a party to the proposition, and this identifier is communicated to the party to enable the party to record a spoken declaration of assent to the proposition. There are no contracts and instructions provided to a party, there is no providing of the recording identifier to the relying party, and, does not associate a party to the proposition by assigning an identifier to the proposition.

In inventions V a party receives a contract and instructions, communications between the party to the contract and the recording system is established; recording system provides recording identifier to the party. There are no step wherein relying party associates a transaction identifier with the transaction, and, provides this transaction identifier to the affirming party, and, does not associate a party to the proposition by assigning an identifier to the proposition.

Because these inventions are distinct for the reasons given above and the search required for one Group is not required for other Groups, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention:

For Group I:

Claims 3, 5 is performed over a telephone network,

Claim 4, 6 is performed over a computer network;

Claim 7, 10 is performed using electronic messaging, and,

Claim 9 is performed using paper document.

For Group II:

Claim 12, directed to transaction identifier is received during establishment of communications between the affirming party and the recording system

Claim 13, directed to transaction identifier is received after establishment of communications between the affirming party and the recording system.

For Group II:

Claim 14 claiming dependency on claim 11, is directed to providing of recording identifier to the relying party

Claim 15 claiming dependency on claim 11, is directed to providing the recording identifier to the affirming party.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).



Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on M-F 7:30 - 6:00 (Wednesday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naresh Vig  
Examiner  
Art Unit 3629

February 22, 2006